

### **REMARKS**

The Office Action dated June 22, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 1 has been amended and new claims 3 and 4 have been added. No new matter is presented. Support for the amendments to claim 1 can be found on page 4, lines 6-11 of the specification as originally filed. Support for new claims 3 and 4 can be found in the paragraph bridging pages 2 and 3 of the specification as originally filed. Claims 1-4 are pending and respectfully submitted for consideration.

### **Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 1-2 were rejected under 35 U.S.C. §102(b) as being anticipated by, or alternatively, under 35 U.S.C. §103(a) as being obvious over Statham (U.S. Patent No. 3,732,128). Claim 2 depends from claim 1. The Applicants respectfully submit that claim 1, as amended, recites subject matter that is neither disclosed nor suggested by Statham.

Claim 1 recites a process for thermally treating a light alloy casting, comprising a step of: heating under atmospheric pressure a light alloy casting up to a solid solution range and maintaining it at such heating temperature T. Then, quenching the light alloy casting through a cooling medium while pressurizing it.

Statham discloses that “[i]t has now been discovered that the porous die casting may be treated to 300°C to 600°C without forming blisters if pressure of 100-10,000 p.s.i. is employed during heat treatment. See column 1, lines 58-61 of Statham.

With respect to claim 1, the Applicants respectfully submit that Statham fails to disclose or suggest the claimed features of the invention. Claim 1, as amended, recites heating under atmospheric pressure a light alloy casting up to a solid solution range and maintaining it at such heating temperature T. In contrast, Statham teaches heating a die casting under a pressure of 100 to 10,000 p.s.i. prior to cooling. See column 1, lines 35-42 of Statham. As such, Statham fails to disclose or suggest at least the feature of heating under atmospheric pressure, as recited in amended claim 1.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that Statham does not disclose or suggest at least the feature of heating under atmospheric pressure a light alloy casting as recited in claim 1. Accordingly, Statham does not anticipate claim 1, nor is claim 1 obvious in view of Statham. As such, the Applicants respectfully submit that claim 1 is allowable over Statham.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. In this case, Statham does not disclose or suggest all of the claim limitations, in particular heating under atmospheric pressure a light alloy casting up to a solid solution range and maintaining it at such heating temperature T. Accordingly, the Statham does not support a *prima facie* case of obviousness for purposes of a rejection of claims 1 and 2 under §103.

### **Conclusion**

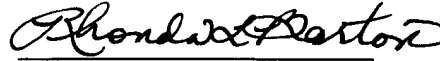
Claims 2-4 depend from claim 1. The Applicants respectfully submit that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicants respectfully request withdrawal of the rejections, allowance of claims 1-4, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper,

may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107348-00363.**

Respectfully submitted,



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Enclosure: Petition for Extension of Time (3 months)

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